

## REMARKS

Reconsideration and allowance of the subject application are respectfully requested, in light of the above claim amendments and the following comments.

### Status of the Claims

Claims 1-78 are pending in this application, with Claims 1, 11, 17, 44, 51-55 and 66 being independent. Claims 1-16, 24-37 and 51-55 have been withdrawn from consideration.

### Support for the Above Claim Amendments

Claims 17, 44 and 66 have been amended herein.

As previously worded, independent Claims 17, 44, and 66 all called for the combination of (a) a transfer-resistant basecoat composition containing a cross-linked resinous silicone with (b) an overcoat composition containing, as a wetting agent, a liquid polymeric hydrocarbon having a number average molecular weight greater than about 650. Claim 44 specifies that the polymeric hydrocarbon is an alpha olefin polymer. Claim 66 specifies that the resinous silicone is a trimethylsiloxysilicate and that the polymeric hydrocarbon is an alpha olefin polymer.

Applicants have now added to those claims the additional feature that the wetting agent overcoat composition “flows smoothly over the anhydrous pigmented transfer resistant composition.” Support for this feature may be found, for example, at page 6, lines 20-

23 of the specification as originally filed. Accordingly, Applicants submit that no new matter has been added.

#### Support for the New Claims

Claims 76-78 are newly added.

Each of claims 76-78 recites that the wetting agent overcoat composition is devoid of mineral oil.

Example 2 in Applicants' specification discloses the results when 58 different overcoat compositions were applied over a transfer-resistant basecoat containing a resinous silicone. Of those 58 different combinations, four meet the limitations of Claims 17, 44, and 66. Those are the combinations in which one of the following polymeric hydrocarbons was used as the overcoat composition: Indopol H-100, Indopol H-50, Parapol 700, and Synton PAO 100. (See page 29, items 1, 3, 6, and 7 under the heading "HYDROCARBONS.") In all four of those combinations there was no mineral oil in the overcoat composition, and all four combinations performed well, getting scores of 1 or -1 on a transfer-resistance scale of 0 to 3, in which 0 is the highest possible score and 3 is the lowest. Id.

Applicants submit that this disclosure in Example 2 clearly allows persons of ordinary skill in the art to recognize that Applicants invented the combined use of a resinous-silicone-containing basecoat composition with an overcoat composition that contains a polymeric hydrocarbon having a number average molecular weight greater than about 650 and that is devoid of mineral oil. Therefore, the addition of the claims reciting that the overcoat

composition is “devoid of mineral oil” does not constitute “new matter.” See Union Oil Co. of Cal. v. Atl. Richfield Co., 208 F.3d 989, 997, 54 USPQ2d 1227, 1232 (Fed. Cir. 2000) (“The written description requirement does not require the applicant ‘to describe exactly the subject matter claimed, [instead] the description must clearly allow persons of ordinary skill in the art to recognize that [the inventor] invented what is claimed.’” (citation omitted)).

### Rejections

In the latest Office Action, Claims 17-23, 38-50 and 56-75 were rejected under 35 U.S.C. § 112, second paragraph, as being indefinite. Specifically, the Examiner suggested that the term “substantially” in independent Claims 17, 44 and 66 rendered the claims indefinite. Without conceding the propriety of the rejection, Applicants have amended each of Claims 17, 44 and 66 to delete the term “substantially.” Accordingly, Applicants submit that the claims fully comply with § 112, second paragraph. Reconsideration and withdrawal of the § 112, second paragraph, rejection are requested.

Claims 17-19, 21, 23, 38-44, 46-50, 58 and 59 were rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over U.S. Patent No. 6,074,654 (Drechsler et al.) in view of Manufacturing Chemist, ExxonMobile Chemical Technical Data, and U.S. Patent No. 5,970,989 (Litton). Claims 17-19, 21, 22, 38-44, 46-50, 56 and 57 were rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Drechsler et al. in view of U.S. Patent No. 4,935,228 (Finkenaure et al.), Amoco Technical Data and Litton. Claim 20 was rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Drechsler et al., Finkenaure et al., Amoco

Technical Data and Litton, and further in view of U.S. Patent No. 6,509,009 B2 (Nichols).

Claim 45 was rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Drechsler et al., Finkenauf et al., Amoco Technical Data, and Litton, and further in view of U.S. Patent No. 3,871,543 (Chadfield et al.). Claims 60-75 were rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Drechsler et al., Finkenauf et al., Amoco Technical Data and Litton, and further in view of STN-REGISTRY. These rejections are respectfully traversed.

Applicants' invention as recited in independent Claim 17, as amended, is directed to a multipack lip cosmetic including at least two separate receptacles in a single stock keeping unit. The first receptacle contains an anhydrous, pigmented, transfer-resistant composition that includes a film-forming, cross-linked, resinous silicone; a volatile solvent; and pigment. The second receptacle contains a wetting agent overcoat composition for the transfer resistant composition. The wetting agent overcoat composition includes a wetting agent that is non-reactive with, but affinitive to, the transfer-resistant composition. The wetting agent is a liquid polymeric hydrocarbon having a number average molecular weight greater than about 650, is devoid of non-volatile silicone oils, and flows smoothly over the anhydrous, pigmented, transfer-resistant composition.

Applicants' invention as recited in independent Claim 44, as amended, is directed to a multipack lip cosmetic that includes at least two separate receptacles in a single stock keeping unit. The first receptacle contains an anhydrous, pigmented, transfer-resistant composition that includes a film-forming, cross-linked, resinous silicone; a volatile solvent comprising isododecane; and pigment. The second receptacle contains a wetting agent overcoat

composition for the transfer resistant composition. The wetting agent overcoat composition includes an alpha olefin polymer that is a liquid polymeric hydrocarbon that is non-reactive with, but affinitive to, the transfer resistant composition and has a number average molecular weight greater than about 650. The wetting agent overcoat composition is devoid of non-volatile silicone oils and flows smoothly over the over the anhydrous, pigmented, transfer-resistant composition.

Applicants' invention as recited in independent Claim 66, as amended, is directed to a multipack lip cosmetic that includes at least two separate receptacles in a single stock keeping unit. The first receptacle contains an anhydrous, pigmented, transfer-resistant composition that includes (a) a film-forming trimethylsiloxysilicate, (b) a solvent component in which the trimethylsiloxysilicate is dissolved or dispersed, the solvent component comprising isododecane and a silicone oil, (c) pigment, and (d) a viscosity increasing amount of a quaternized hectorite. The second receptacle contains a wetting agent overcoat composition for the transfer resistant composition. The wetting agent overcoat composition includes an alpha olefin polymer that is a liquid polymeric hydrocarbon that is non-reactive with, but affinitive to, the transfer-resistant composition, and that has a number average molecular weight greater than about 650. The wetting agent overcoat composition is devoid of non-volatile silicone oils and flows smoothly over the anhydrous, pigmented, transfer-resistant composition.

For the following reasons, Applicants submit that the cited art fails to teach many features of Applicants' claimed invention.

Drechsler et al. is directed to transfer-resistant cosmetic compositions and discloses the complementary use of a basecoat composition and an overcoat composition. Drechsler et al. discloses at column 11, lines 2-5 that an overcoat composition is used “to enhance the gloss and shine of the lips and provide a lubricious feeling.” Regarding the overcoat composition, the Examiner acknowledges that Drechsler et al. fails to teach or suggest the use of a liquid polymeric hydrocarbon that has a number average molecular weight greater than about 650. To remedy this deficiency, the Examiner cites to Manufacturing Chemist and to Finkenaur et al.

Manufacturing Chemist discloses that poly-a-olefins (notably polydecene) are popular as oil-free emollients, that they are colorless, odorless and non-greasy, are used as pigment wetting and dispersing aids and are recommended as a replacement for mineral oil. From this disclosure, the Examiner suggests that it would have been obvious to one of ordinary skill in the art to modify the invention of Drechsler et al. by adding the poly-a-olefins disclosed in Manufacturing Chemist. Applicants respectfully disagree and submit that the proposed combination is based on impermissible hindsight.

Applicants note that there is no teaching or suggestion in either Drechsler et al. or Manufacturing Chemist that emollients are useful as overcoat compositions or that an emollient would provide a lubricious feeling. Moreover, the term “emollient”, which Webster’s Third New International Dictionary defines as “making soft or supple” or “soothing esp. to the skin or mucous membrane,” does not suggest providing a lubricious feeling. WEBSTER’S THIRD NEW INTERNATIONAL DICTIONARY 742 (1993). Moreover, neither ExxonMobile Chemical

Technical Data, which was cited for disclosing non-greasy poly-a-olefins having a specific molecular weight, nor Litton, which was cited for disclosing packaging cosmetic components together, are understood to remedy these deficiencies. Accordingly, because of the lack of a specific teaching that emollients are useful as overcoat compositions in cosmetics and provide a lubricious feeling, Applicants submit that the rejection picks and chooses features from the various references and merely identifies an advantage noted in each reference as motivation for the combination. Applicants also submit that it does not necessarily follow that those advantages would become manifest if the combination was made in the manner proposed. Accordingly, Applicants submit that the rejection is not well-founded.

The Examiner also cited to Finkenaar et al. to remedy the above-noted deficiencies of Drechsler et al. Finkenaar et al. discloses that polybutene can be added to a mineral oil gel lip gloss to improve wear resistance. As demonstrated in the Declaration Under 37 C.F.R. 1.132, however, the lip gloss containing polybutene, according to the formula disclosed in Example 2 of Finkenaar et al., results in a thick, sticky, stringy gum that is not easily spread on the lips. Accordingly, Applicants submit that Finkenaar et al. does not teach or suggest that the lip gloss flows smoothly over an anhydrous, pigment, transfer resistant composition, as recited in independent Claims 17, 44 and 66.

Amoco Technical Data, which was cited for disclosing a polybutene having a specific molecular weight, and Litton, which was cited for disclosing packaging cosmetic components together, are not understood to remedy the above-noted deficiencies of Drechsler et al. and Finkenaar et al.

Nichols et al. was cited for teaching a makeup remover composition.

Chadfield et al. was cited for teaching a container made of styrene. STN-REGISTRY was cited for teaching a quaternized hectorite. None of these references, however, is understood to remedy the above-noted deficiencies of Drechsler et al. and Finkenaur et al.

In view of the foregoing, Applicants submit that the rejections are not well founded and that the cited references fail to teach or suggest many features of Applicants' claimed invention. Reconsideration and withdrawal of the rejections under 35 U.S.C. § 103 are therefore requested.

Applicants submit that the present invention is patentably defined by independent Claims 17, 44 and 66. Dependent Claims 18-23, 38-43, 45-50, 56-65 and 67-78 are also patentable, in their own right, for defining other important features of the present invention, in addition to those recited in the independent claims.

Applicants respectfully request that this Amendment After Final be entered. This Amendment was not presented earlier as it was earnestly believed that the claims on file would be found allowable. Given the Examiner's familiarity with the application, Applicants believe that a full understanding and consideration of this Amendment would not require undue time or effort by the Examiner. Moreover, Applicants submit that this Amendment places the application in condition for allowance. Accordingly, entry of this Amendment is believed to be appropriate and such entry is respectfully requested.




Applicants submit that this application is in condition for allowance.

Favorable reconsideration, withdrawal of the rejections set forth in the above-noted Office Action, and an early Notice of Allowability are requested.

Applicants' undersigned attorney may be reached in our Washington, D.C. office by telephone at (202) 530-1010. All correspondence should continue to be directed to our below-listed address.

Respectfully submitted,

  
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